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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/338,729
Filing Date: June 23, 1999
Appellant(s): GROSS, DENNIS

KING WONG
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 28, 2005, appealing from the Office action mailed on June 16, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

5,505,948	RAPAPORT	04-1996
4,797,273	LINN et al.	01-1989
5,804,203	HAHN et al.	09-1998
5,811,111	MCATEE et al.	09-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The broadest claim in the present application is Claim 117, which is directed to a method of treating skin, comprising the sequential step of a) applying to the skin a first liquid composition of pH of 2.5-4 which comprises an acidic agent; b) neutralizing the composition by applying to the skin a second composition of pH 7-12, which comprises at least one surfactant/emulsifier and an alkaline agent; and c) applying to the skin a moisturizer, sun screen and/or makeup without proceeded by rinsing off the first and second compositions from the skin.

Another independent claim, Claim 90, is directed to the similar method but requires 0.1-10 % of the surfactant/emulsifier in the second composition, and also requires the second composition to dry on the skin before applying to the skin the moisturizer, sunscreen and/or makeup when the first and second compositions remain on the skin.

In Claim 40, the invention is directed to yet another similar method, but requires specific ingredients and the amounts in the first and second compositions. Claim 44 also differs from Claims 117 and 90 in that the method is for treating the skin of a consumer and method consists essentially of the sequential steps of a) applying to the skin first composition by massaging into the skin with a pad saturated with the composition; b) allowing the composition to dry on the skin; c) neutralizing the first composition by applying the second composition by massaging into the skin with a pad saturated with the composition; d) allowing the composition to dry on the skin; and e) applying a moisturizer, sunscreen and/or makeup to the skin when the first and second compositions remain on the skin.

Claim 44 is directed to a method *consisting essentially of* the same method steps as recited in Claim 40. It is respectfully pointed out that the purpose of searching for and applying prior art under 35 U.S.C. §§ 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually, “consisting essentially of” will be construed as equivalent to comprising. If an applicant contends that additional steps in the prior art are excluded by the recitation of “consisting essentially of”, applicant has the burden of showing that the introduction of additional steps would materially change the characteristics of applicant’s invention. See MPEP § 2111.03.

Claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70-73, 77-78, 85, 88, 90-99, 101-106, and 109-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 5720949) in view of Rapaport (US 5505948).

Davis teaches a skin peel cosmetic mask which is applied to the skin, particularly the face of a consumer. See col. 1, lines 35 –49. The prior art teaches that the notion of treating the skin by the heat and foam that are generated by sequentially applying an effervescent agent and acid components is well known. The reference teaches that these compositions are applied in any convenient order, and particularly teaches that the acid composition is applied first if an enhanced exfoliation of the skin is desired or in the absence of pretreatment with alpha- or beta-hydroxy acids. See col. 10, lines 43-51. See instant claim 47, 49, 50.

The reference teaches that one composition may be in the form of a cream mask, comprising i) 0-25 % of a nonliquid organic material of moderate melting point ii) 1-25 % of a surfactant system iii) 40-90 % of water; and iv) a thickening agent to provide a viscosity of 50,000 to 1million cps at 25 °C. The reference teaches using 1-20 % of an effervescent agent, particularly sodium bicarbonate. See col. 7, lines 32 – 43. The cream mask composition is said to have a pH range of 7.5-9, and contains 0.05-0.1% of essential oils and astringents, particularly witch-hazel. See col. 7, lines 57 – col. 8, line 13. Using sodium hydroxide is also taught in col. 12, lines 15 – 26. Surfactants such as ceteareths, ceteths, laneths, nonoxynols, octoxynols, glyceryl stearate, PEG-castor oil, poloxamers, poloxamines, and steareths are taught at col. 5, line 47- col. 6, line 35. See instant claims 11-15, 101-103, and 116.

The other composition is in the form of gel, ("the Gel Activator"), and provides a carrier for the acid component. The composition contains i) 55-90 % of an organic solvent; ii) a thickening agent to provide a viscosity of 25,000 – 500,000 cps at 25 C; iii)

0-20 % of water; and iv) a buffering agent to provide pH of 3.5-6. See col. 8, lines 50-64. Using lactic, glycolic, and salicylic acids is taught, wherein salicylic acid and lactic acids are "especially preferred". See col. 8, lines 65 – col. 9, line 13. Malic and citric acids are also taught. See Id. The reference cautions of skin irritation by the acids, and teaches using 1-30 %, preferably 5-15 % of the acids by weight of the composition. See instant claims 28, 29, 36, 43, 85, 91-93, and 115.

While Davis teaches that the effervescent composition is in the form of "cream mask", examiner views that the "liquid" limitation of the instant claim is an obvious variation of the prior art. Davis teaches that lotion or tonic products, which are less viscous than cream mask, are applied to the skin of consumer by massaging these products into the skin. See col. 1, lines 27 – 32. Whether the composition is in the form of mask or liquid, these conventional forms are merely viewed as different means of delivery of active ingredients into the skin so that the reaction of the effervescent agent and acid component can take place thereon, which can be substituted by one for the other. See also Example 4, which teaches that sodium bicarbonate is contained in the gel accelerator and the lactic acid is in the cream composition. The motivation to make less viscous compositions to shorten the reaction time is also found in col. 11, lines 37 – 40, which teaches that viscosity of the compositions delays the time for complete reaction.

Davis teaches that first composition can remain on the skin for up to 10 minutes, and the combination of the first and second compositions can be maintained in contact on the skin for up to about 30 minutes. See col. 10, lines 52 – 65; col. 11, line 66 – col.

12, line 5. Thus, the compositions are given time to dry once they are applied to the skin. See instant claims 47, 49, 50, 70, 72, 73, 90, 111, and 112.

The claimed inventions in instant claims 117, 90, and 44 also requires that the first and second compositions not be “rinsed” or remain on the skin. While Davis teaches, “the residue is removed by means of a cloth or scraper. The face of the consumer may then be washed with a gentle soap composition.” See col. 12, lines 2-5. Although Example 1 shows washing the composition off the skin with a soap composition, Examiner views that “rinsing” is an optional method step in the prior art since the reference teaches that it *may* be washed. Furthermore, the description of the invention in col. 1, lines 46-48 merely indicates that the residue is removed from the skin of the user by means or scraper or cloth without further mentioning rinsing the skin. Nonetheless, Davis clearly teaches that massaging lotion or cream compositions into the skin does not require removing the composition. See col. 1, lines 26 – 32.

While Davis teaches surfactants and conventional cosmetic additives for the compositions, the reference fails to teach resorcinol in the acidic composition, as required in instant claims 40, 44, 77, 78, 104, 107, and 108. For Claims 40, 44, 46, 105, and 106, a composition comprising at least 0.1 % of sodium bicarbonate and 0.1 % of surfactant/emulsifier in 100 % balance of water meets the limitation of the second composition. Davis also lacks the method step of applying moisturizer, sunscreen or makeup composition after the treatment. Using a pad to apply the compositions is not explicitly mentioned.

Rapaport teaches home skin peeling/exfoliating compositions which comprises disodium EDTA, sodium benzoate, witch hazel, polysorbate (surfactant), salicylic acid, lactic acid, glycolic acid, resorcinol, dissolved ammonia, acetone, Germall 115 (imidazolidinyl urea, a preservative), alcohol, and water within the claimed amount. See instant claims 40, 44, 77, 78, 94-99, 104, 107, and 108. The reference further teaches that applying moisturizer and sunscreen to the skin after an acid peel to protect the skin is well known in the art. See col. 13, lines 34-56. The reference also teaches using applicator pad or pre-saturated pad of various constructions to apply the peeling/exfoliating compositions to achieve an abrasive effect for scraping, removing and cleansing action. See col. 10, lines 18-67. See instant claims 33-35, 109-110.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the skin treatment method of Davis by substituting the Rapaport acid peel/exfoliation composition for the acidic composition, as motivated by Rapaport, because 1) Davis teaches that it may be desirable to maintain an acidic composition on the skin for a gentle peel; 2) and the skilled artisan would have had a reasonable expectation of successfully achieving a gentle acid-peeling effects while the composition remains on the skin, as taught by Rapaport.

Claims 76, 100, 107, and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis and Rapaport as applied to claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70-73, 77-78, 85, 88, 90-99, 101-106, and 109-117, and further in view of Linn et al. (US 4797273), Hahn et al. (US 5804203), and McAtee et al. (US 5811111).

Davis further teaches providing a skin conditioning regiment by applying a product rich of moisturizers, emollients, and humectants before the treatment. See col. 10, lines 1 – 30. The reference teaches to incorporate into the cream composition skin conditioning agents, preservatives such as methyl paraben, imidazolidinyl urea, antioxidants such as sodium ascorbate, tocopherol acetate, and trisodium EDTA. See col. 8, lines 14 – 49. Since the reference teaches here that salicylic acid, although not used in the composition comprising the effervescent agent, is an anti-acne agent it would have been obvious to a skilled artisan to use other suitable anti-acne agent. See col. 8, lines 14 – 35. While Davis teaches octoxynol, the combined references fail to teach octoxynol-9. Dimethicone copolyol, green tea extract, phospholipids, vitamin A, ascorbyl palmitate, phenoxyethanol, diazolidinyl urea, and tetrasodium EDTA are not specifically mentioned in the reference.

Linn et al. teach skin moisturizing microemulsions. Octoxynol-9 is taught as a cosmetically acceptable surfactant. See col. 6, lines 14-33.

Hahn et al. teach that it is well known in cosmetic art to use green tea extract as an anti-irritant, Phospholipid PTC as a surfactant/moisturizer, Germaben II (diazolidinyl urea) as a preservative, ascorbyl palmitate as an antioxidant, vitamin A as an anti-acne agent, and dimethicone copolyol as a silicone carrier to produce a clear gel. See col. 4, lines 11-12; col. 19, lines 8-56. See Examples 3 & 6 for the amounts.

McAtee et al. teach that phenoxyethanol is among the most preferred antimicrobial used in a topical composition. See col. 10, lines 7 – 12. A leave-on formulation comprising tetrasodium EDTA is taught in Example 1.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modified the composition of the combined references by adding octoxynol-9 as the surfactant in the alkaline composition because 1) Davis teaches octoxynol; 2) it is known within the skill in the art to substitute one know species of surfactant for another; and 3) the skilled artisan would have had a reasonable expectation of successfully achieving similar surfactant effects that are cosmetically acceptable. The Hahn reference also would have motivated the skilled artisan to further incorporate the well-known cosmetic additives such as green tea extract, phospholipid, diazolidinyl urea, ascorbyl palmitate, vitamin A, and dimethicone copolyol because of the expectation of successfully producing a cosmetic composition with the desired cosmetic effects as taught. The skilled artisan would have been also motivated to use phenoxyethanol and tetrasodium EDTA as motivated by McAtee because of the expectation of successfully achieving antimicrobial and chelating effects, respectively, that are cosmetically suitable.

(10) Response to Argument

A. The combined teachings of Davis and Rapaport would have motivated one of ordinary skill in the art would to achieve the claimed inventions.

Examiner initially notes that claims 90 and 117 do not require any specific formulation of the acid composition except for pH range. Davis alone teaches and suggests the claimed method steps of treating skin by sequentially applying acid and base compositions to allow neutralization to occur on the skin. Davis teaches that formulating a liquid composition by modifying the cream mask composition would have

been within the skill of the art. With respect to claims 90 and 117, the difference between Davis and the claimed invention is the post-treatment step to moisturize and/or protect the treated skin. The claimed invention there is viewed obvious because Rapaport teaches that the post-treatment step is conventionally practiced after or as a part of a cosmetic skin care regime. In view of the combined teachings of Davis and Rapaport, it is obvious that a skilled artisan would have arrived at the claimed methods at the time of the present invention.

With respect to claims 40 and 44, the required specific formulation of the acid composition is not taught in Davis, although the reference does teach using the specific alpha- and beta-hydroxy acids (i.e., glycolic acid, lactic acid, and salicylic acids) that are used in the claimed invention. The specific acid skin peeling composition comprising these acid components that appellant claims here, is disclosed in Rapaport. Thus it is viewed obvious that the skilled artisan would have been motivated to substitute one acid peeling composition for another, because these are equivalents well known for the same purpose.

Examiner asserts that a prima facie case of obviousness has been established in this case, as the evidence of the record clearly indicates that one of ordinary skill in the art would have found a motivation to modify the Davis invention in the form of lotion and subsequently apply a moisturizer as a post-treatment regime. It would have been further obvious to the skilled artisan to use the Rapaport acid peeling composition in place of the Davis' formulation in expectation of achieving similar skin peeling treatment effects. It is also noted that while the combined teachings of the references teach that

the claimed methods are well known and obvious, there is no evidence in the record to indicate any unexpected or nonobvious results in using liquid formulation, in applying moisturizer as a post-treatment step, and in using the Rapaport composition as a skin peeling agent. Appellant's arguments are addressed below.

1. According to Davis, making a liquid composition by modifying the Davis invention would have been obvious to one of ordinary skill in the art.

Appellant argues that Davis is limited to applying viscous mask composition that must be washed off before applying a moisturizer. The argument is unpersuasive. While Davis is directed to a using cream mask and gel compositions, the reference also teaches that lotion or cream formulation that are massaged into the skin had been widely used in the art. See Davis See col. 1, lines 27 – 32. The reference also teaches that these compositions are not removed. Thus whether the composition is in the form of viscous cream mask or liquid, these conventional forms are merely viewed as different means of carriers for the active ingredients to the skin so that the reaction of the effervescent agent and acid component can take place thereon. Since cream mask and liquid formulations are both used for the same purposes, these are it would have been obvious to substitute one over the other. Furthermore, as mentioned above, while Davis teaches scraping off the residues of the acid/base reaction, the reference teaches that washing off or the removal of the composition is an optional step. Thus, appellant's method, which employs "liquid" composition as opposed to the viscous Davis' composition, is an obvious modification of the Davis method.

2. The combined teachings of Davis and Rapaport would have motivated a skilled artisan to apply the post-treatment moisturisation step as done by appellant.

Appellant asserts that Davis allegedly teaches away from applying a moisturizer when the cosmetic mask is on the skin, as the reference teaches applying a moisturizing cream before applying the acid composition in col. 10, lines 1-11, 31-33, and column 12, lines 6-14. However, the reference specifically teaches in col. 11, lines 40 – 50, in case where the user desires a gentle peel of the skin, the acidic composition is used in stoichiometric excess over the effervescent base agent, and “no pretreatment with an exfoliating moisturizing cream occurs in such case”. Thus, a skilled artisan would not have used the moisturizer prior to the acid/base neutralization step. As shown by Rapaport, the post-treatment step to moisturize and/or protect skin after or as a part of the skin peeling procedure is a conventional method.

3. It would have been obvious for a skilled artisan to use the Rapaport acid peeling formulations in place of the Davis acid composition because both are known to be used for the same purpose.

Appellant asserts that Rapaport teaches away from combining the teachings with Davis because the Rapaport acid composition is “intended to be used without neutralization”. However, Rapaport does not in any way teach against neutralization step in the skin peeling process. The reference merely teaches that neutralization is optional and is still needed in order to avoid the wounding of living skin tissue by the harsh skin peeling agents. See Rapaport, col. 11, lines 23 – 29. An acid/base skin-

peeling regime, which requires neutralization method, is well known in cosmetic art, as seen in Davis. The pH of the acid composition in Davis is 3.5-6, which overlaps with the pH range of the claimed invention. It would have been obvious to a skilled artisan to apply a neutralizer after applying a skin peeling acidic composition of such pH range.

Furthermore, appellant asserts that the rejection is improper because Davis teaches using stoichiometric excess of an acid composition for a gentle peel process, which would not result in neutralization of all acidic components. In response, examiner respectfully points out that the teaching of the reference is clear on the purpose of using excess amount of either acid or base compositions. The reference teaches using stoichiometric excess of base is used in order to completely neutralize the acidic components, while excess acidic composition is used if the user desires a gentle peel. Thus, the skilled artisan has motivation to either completely neutralize the acidic composition by using excess amount of base composition; or "maintain the acid composition following the complete reaction" by applying stoichiometric excess amount of acid over the base agent. It is respectfully pointed out that the claimed inventions do not even require any specific amount of the neutralizing composition to be applied, thus whether the Davis teaches partial or complete neutralization of the acid is not a relevant issue here.

Appellant assert that Rapaport does not suggest an acid composition to be neutralized by an alkaline composition. The argument is unpersuasive. Rapaport indicates that neutralization is required in order to reduce the harsh effects of the skin peeling alpha-hydroxy acids on the skin. Davis, Rapaport, and appellant use the same

acid peeling agents, namely, lactic, salicylic, and glycolic acids. The Davis skin peeling procedure requires maintaining the acidic composition on the skin by applying stoichiometric excess of amount of acid over the base agent, thus the base composition is used to neutralize some of the acidic components. Davis also teaches using the acid composition in the acidic pH range that overlaps with appellant's invention, while Rapaport teaches the exact same formulation which appellant employs in the present invention. Thus the skilled artisan would have preferred to neutralize the acidic composition in the same pH range as Davis in order to avoid skin wounding by the skin peeling agents.

B. One of ordinary skill in the art would have found motivation to make the claimed invention in claims 76, 100, 107, and 108 by combining Davis, Rapaport, Linn et al., Hahn et al. and McAtee et al.

Appellant's arguments are based on the assertion that the rejection made over Davis in view of Rapaport is improper. Examiner respectfully disagrees as discussed above, and the arguments are moot.

For the above reasons, it is believed that the rejections should be sustained.

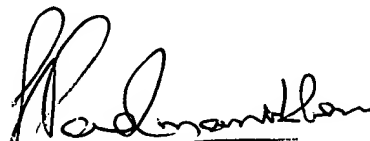
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